REPLY UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER 2100
Docket No. 1793.1075

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Hyun-Kwon CHUNG, et al.

Serial No. 10/686,537 Group Art Unit: 2194

Confirmation No. 4036

Filed: October 16, 2003 Examiner: Nathan E. Price

For: DATA STORAGE MEDIUM HAVING INFORMATION FOR CONTROLLING BUFFERED STATE OF MARKUP DOCUMENT, AND METHOD AND APPARATUS FOR REPRODUCING DATA FROM THE DATA STORAGE MEDIUM

PETITION UNDER 37 CFR 1.181(a) FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION AND RESTARTING OF PERIOD FOR RESPONSE

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Sir:

The Examiner issued a Final Office Action on November 15, 2007, in response to the Amendment of September 5, 2007. However, it is submitted that the finality of the Final Office Action is premature for the following reasons.

The Final Office Action of November 15, 2007, contains two new grounds of rejection in which claims 1-9 have been rejected under 35 USC 101 as being directed to non-statutory subject matter, and claims 1, 8, and 9 have been rejected under 35 USC 102(b) as being anticipated by the newly cited Sullivan reference. On page 11 of the Final Office Action, the Examiner states "[a]pplicant's amendment necessitated the new ground(s) of rejection presented in this Office action," relying on MPEP 706.07(a).

Claims 8 and 9 were added in the Amendment of September 5, 2007, and accordingly the new grounds of rejection of claims 8 and 9 were necessitated by the Amendment of September 5, 2007.

However, although claims 1-7 were amended in the Amendment of September 5, 2007, it is submitted that the new grounds of rejection of claims 1-7 were not necessitated by the amendments to claims 1-7.

The only amendments made to claims 1-7 in the Amendment of September 5, 2007, were that claim 1 was amended to recite "[a] computer-readable medium having recorded thereon," rather than "[a] data storage medium, comprising" as originally filed, and claims 2-7 were amended to recite "[t]he computer-readable medium of claim," rather than "[t]he data storage medium of claim" as originally filed.

In explaining the new ground of rejection of claims 1-9 under 35 USC 101, the Examiner states as follows on page 6 of the Final Office Action of November 15, 2007:

> Claims 1 – 9 are directed to a signal directly or indirectly by claiming a medium and the Specification (¶ 95) recites evidence where the computer readable medium is defined as a "wave" (such as a carrier wave). In that event, the claims are directed to a form of energy, which at present the office feels does not fall into a category of invention.

Paragraph [0095] of the specification referred to by the Examiner reads as follows:

> **[0095]** It is understood that a system which uses the present invention also includes permanent or removable storage, such as magnetic and optical discs, RAM, ROM, a carrier wave medium, etc., on which the process and data structures of the present invention can be stored and distributed. The operations can also be distributed via, for example, downloading over a network such as the Internet.

This paragraph does not specifically refer to a "computer-readable medium" as now recited in claims 1-7, or a "data storage medium" as previously recited in claims 1-7, but refers to "permanent or removable storage," one example of which is "a carrier wave medium." Thus, the new ground of rejection under 35 USC 101 of claims 1-7 that now recite a "computer-readable medium" is also applicable to the previous version of claims 1-7 that recited a "data storage medium," such that the new ground of rejection of claims 1-7 under 35 USC 101 was not

necessitated by the amendment of claims 1-7 to recite a "computer-readable medium" rather than a "data storage medium."

Rather, the Examiner's statement that "in that event, the claims are directed to a form of energy, which at present the office feels does not fall into a category of invention" appears to indicate that the new ground of rejection of claims 1-7 under 35 USC 101 is based on the decision of *In re Nuijten*, 500 F.3d 1346, 84 USPQ2d 1495 (Fed. Cir. 2007), which was decided on September 20, 2007, after the Amendment of September 5, 2007, was filed, and held that Nuijten's signal claims are not patentable subject matter under 35 USC 101. Accordingly, it is submitted that the new ground of rejection of claims 1-7 under 35 USC 101 was actually necessitated by the issuance of the *Nuijten* decision, rather than by the amendment of claims 1-7 to recite a "computer-readable medium" rather than a "data storage medium."

In explaining the new ground of rejection of claim 1 under 35 USC 102(b) as being anticipated by Sullivan, the Examiner states as follows on page 7 of the Final Office Action of November 15, 2007:

> As to claim 1, Sullivan teaches a computer-readable medium having recorded thereon:
>
> AV data [p. 75 ¶ 1];
>
> a markup document which is provided to reproduce the AV data in an interactive mode [p. 75 ¶ 1 – 2; p. 78 ¶ 1 – 3]; and
>
> control information which is provided to identify buffering state information of the markup document to be preloaded [p. 75 ¶ 1 – 2; p. 78 ¶ 1 – 3; p. 95 ¶ 1 – p. 96 ¶ 4; p. 97 last ¶; p. 177 last ¶; p. 33 ¶ 2; p. 45 ¶ 2].

However, the Examiner has not identified any element in Sullivan that can be considered to be a "computer-readable" medium but not a "data storage" medium. Thus, the new ground of rejection under 35 USC 102(b) of claims 1 that now recites a "computer-readable medium" is also applicable to the previous version of claim 1 that recited a "data storage medium," such that the new ground of rejection of claim 1 under 35 USC 102(b) was not necessitated by the amendment of claim 1 to recite a "computer-readable medium" rather than a "data storage medium."

Furthermore, in paragraphs 5 and 6 on pages 3 and 4 of the Final Office Action of November 15, 2007, the Examiner has relied on the newly cited Goodman and *American*

Heritage College Dictionary references to support the rejection of claims 1-7 under 35 USC 103(a) as being unpatentable over Landsman in view of Silberschatz, stating that "[a]dditionally, Goodman [see PTO-892 with this Office Action] teaches JavaScript files are markup documents [p. 17 ¶ 3]," and "[s]ee definition of 'interactive' in dictionary cited on PTO-892 with this Office Action."

MPEP 706.02(j) provides as follows:

> Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See *In re Hoch,* 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

Accordingly, it is submitted that the Examiner was required to include the Goodman and *American Heritage College Dictionary* references in the statement of the rejection of claims 1-7 under 35 USC 103(a) as being unpatentable over Landsman in view of Silberschatz. Furthermore, it is submitted that this would constitute a new ground of rejection pursuant to the following guidelines set forth in MPEP 1207.03(III):

> A new prior art reference applied or cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970).

Here, it is submitted that the Examiner's reliance on the Goodman and *American Heritage College Dictionary* references to support the rejection of claims 1-7 under 35 USC 103(a) as being unpatentable over Landsman in view of Silberschatz clearly constitutes a new ground of rejection under the above guidelines set forth in MPEP 706.02(j) and 1207.03(III). It is submitted that this new ground of rejection was not necessitated by the amendment of claims 1-7 to recite a "computer-readable medium" rather than a "data storage medium."

Accordingly, for at least the foregoing reasons, pursuant to MPEP 706.07(c), it is submitted that the finality of the Final Office Action of November 15, 2007, is premature pursuant to MPEP 706.07(a), and pursuant to 37 CFR 1.181(a) and MPEP 706.07(d) and 710.06, it is

respectfully petitioned that the finality of the Final Office Action of November 15, 2007, be withdrawn and that the period for response be restarted.

If there are any additional fees associated with the filing of this paper, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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